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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PALM-3649.SG

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on December 22, 2008Signature /Mina Oliveri/Typed or printed name Mina Oliveri

Application Number

09863232

Filed

2001-05-21

First Named Inventor

Greg Arnold

Art Unit

2143

Examiner

Shin, Kyung H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

<input type="checkbox"/>	applicant/inventor.	<u>/Anthony C. Murabito/</u>
		Signature
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/99)	<u>Anthony C. Murabito</u>
		Typed or printed name
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number <u>35295</u>	<u>(408) 938-9060 ext. 110</u>
		Telephone number
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>December 22, 2008</u>
		Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Arnold and Torres

Serial: 09/863,232

Group Art Unit: 2143

Filed: May 21, 2001

Examiner: Kyung H. Shin

For: METHOD AND SYSTEM FOR USING TOKENS TO CONDUCT FILE SHARING
TRANSACTIONS BETWEEN HANDHELDS AND A WEB SERVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Rejection dated July 21, 2008, Applicants respectfully request review of the final rejection in the above-identified application. Applicants respectfully submit that the Examiner's rejections of the Claims are improper as an essential element needed for a proper *prima facie* rejection under 35 U.S.C. § 103 is missing (e.g., the teaching of all of the recited claim limitations). Claims 1-24 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Multer et al. (US# 6,757,696 B2, "Multer") in view of Coppinger et al. (US 6,757,696, "Coppinger").

ARGUMENTS

With respect to Claim 1, Applicants respectfully assert that Multer fails to teach or suggest the claim limitations of an “account stored on said remote server, said account reserved for a second mobile computing device” as recited by Claim 1. The rejection concedes that Multer fails to disclose these claimed limitations.

However, Multer does not merely fail to disclose these claimed limitations. Multer actually teaches away. For instance, as taught by Multer in column 17 lines 18-20, *inter alia*, an “information store is maintained on a user-by-user basis” (emphasis added). The rejection itself characterizes Multer as teaching “user accounting information for each user” (page 4 “regarding Claim 1,” emphasis added).

Applicants respectfully assert that one of ordinary skill in the art would understand that there is a fundamental difference between the taught user-centric information and the recited “account reserved for a... device.” For example, a user can have multiple devices capable of synchronization, e.g., mobile phone, MP3 player, personal digital assistant, etc. As taught by Multer, information is stored on a user basis. In contrast, the instant limitation recites an account on a device basis.

Consequently, the fundamental organization and principles of operation of Multer are quite different from embodiments of the present invention that recite information storage and/or accounting on a device basis, as recited by Claim 1. Per *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001), “A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant.” As Multer teaches synchronization based on a fundamentally

different accounting organization, Applicants respectfully assert that one of ordinary skill “would be led in a direction divergent from the path that was taken by the applicant” and hence Multer teaches away from the present claimed embodiments.

The rejection argues that the taught “user” is equivalent to the recited “device,” and further argues that a device may have multiple users. Applicants assert that it is uncommon for such a device to contain and synchronize personalized information for multiple users. For example, such devices are known as PIMs – “personal information managers.” Further, the very portability of such devices inherently associates such devices with a single user, e.g., the person who has the device. Thus, such devices are not “multi-user,” and the rejection’s assertion is disproved. Moreover, there is no teaching in the cited art that a device and its synchronization method are shared among multiple users. Thus, the rejection’s position is not supported by the cited art.

For this reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Even though Multer teaches away from this claimed embodiment, the rejection introduces Coppinger to introduce missing teachings. The rejection alleges that Coppinger teaches “accessing an account stored on the remote server,” cited to [0059]. However, Coppinger teaches “[t]o register a wireless device, an account is created [0059, emphasis added]. Thus, the cited portion merely teaches creation of an account. Coppinger describes some information that may be posted to the account, including:

the date, the time of day, the operator's identification, a password to be used by the user of the wireless device, type and subtype of wireless device (e.g., cell phone with email capability), features of the wireless device not implicated by the model number (e.g., already installed software, memory size, etc.), the wireless address of the device (e.g., a telephone number, network node address, IP address, email address, or group address).

Coppinger fails to teach that the account "describ(es) information that is not stored in the second mobile computer device." In fact, the account taught by Coppinger is for a single wireless device, and has absolutely nothing to do with a second wireless device.

As Coppinger fails to correct the deficiencies of Multer, nor ever to teach that which is alleged by the rejection, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Still further, Coppinger teaches wireless synchronization directly between wireless devices, bypassing a server See Table 1 (page 2) describing transactions between wireless devices. Thus, in teaching direct wireless to wireless synchronization, Coppinger actually teaches away from embodiments in accordance with the present invention, and Multer, that recite server-based synchronization. Per *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001), "A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant."

In addition with respect to Claim 1, Multer teaches, "the storage server will be checked to determine whether a new version of the data exists on the storage server (column 34, lines 24-

26). In other words, Multer teaches determining the possible existence of new information as a part of the synchronization process.

In contrast, Claim 1 recites that such new information, “not stored in said second mobile computing device,” is stored on a server. By teaching determining the existence of new information is a part of the synchronization process, Multer teaches a totally different and differentiated method from the recited storage of information “not stored in said second mobile computing device” as recited by Claim 1.

For this further reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Still further with respect to Claim 1, Applicants respectfully assert that Multer fails to teach or suggest the claim limitation of “modifying said account to identify an information that resides on said remote server but not on said second mobile computing device” as recited by Claim 1. For example, Multer teaches, “(after a device connects) the storage server will be checked to determine whether a new version of the data exists on the storage server” (column 34 lines 23-26, emphasis added). Thus, in contrast to the recited limitation of Claim 1, the system of Multer does not know whether information resides on a device until the device connects to the server. Thus, Multer does not teach or suggest modifying an account to identify information “not stored in said second mobile computing device” as recited by Claim 1.

For this still further reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

In summary, Applicants respectfully submit that the Examiner's rejections of the Claims are improper as key limitations needed for proper *prima facie* rejections of Applicants' Claims are not met by the cited references as outlined above.

Respectfully submitted,

MURABITO, HAO & BARNES LLP

Date: 12-22-08

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